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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/637,388 | 08/11/2000 | JAMES B. RILEY | LC-1 | 8885 |

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EXAMINER

VAUGHN, GREGORY J

| | |
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| ART UNIT | PAPER NUMBER |
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2178

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/637,388

Applicant(s)

RILEY ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Application History

1. This action is responsive to the application amendment, filed on 7/12/2004.
2. Applicant has cancelled claims 1-44 and added new claims 45-69.
3. Claims 45-69 are pending in the case, claims 45 and 62 are independent claims.
4. Applicant has amended the specification in response to the objections cited by the examiner in the *Drawings* and *Specification* sections of the previous office action (dated 2/10/2004). Applicant's amendment has addressed the objections previously made, and therefore, in view of the amendment, objections to the drawings and specification are withdrawn.
5. Examiner's rejection of claim 41, made under 35 USC 112 in the *Claim Rejections – 35 USC 112* section of the previous office action (dated 2/10/2004) is withdrawn in view of the cancelled claim.
6. Examiner's objection to claim 35, made under 37 CFR 1.75 in the *Double Patenting* section of the previous office action (dated 2/10/2004) is withdrawn in view of the cancelled claim.
7. Examiner's rejection of claims 1-44, made under 35 USC 102 or 35 USC 103, as being anticipated or unpatentable in view of Rivette et al. US Patent 5,806,079 as recited in the previous office action (dated 2/10/2004) are withdrawn in view of the cancelled claims.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

9. Claims 45-69 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. **Regarding Claims 45-69**, the system and method claimed in claims 45-69 are not embodied on a computer readable medium. Systems and methods not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). See MPEP § 2106 (IV.1.a)

Furthermore, the system and method claimed in claims 45-69 are a non-descriptive data structure. Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. See MPEP § 2106 (IV.1.b)

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

12. Claims 45-48, 50-55, 57-60 and 62-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. US Patent publication 2003/0196164, filed 9/15/1999, published 10/16/2003 (hereinafter Gupta).
13. **Regarding independent claim 45**, Gupta discloses a document annotation system. Gupta recites: *"According to one aspect of the invention, multiple annotations are maintained together as an annotations collection corresponding to particular multimedia content"* (page 1, paragraph 12), where Gupta defines the multimedia content as: *"The data can be as simple as ASCII text or as complex as HTML code which can include text having different fonts and type styles, graphics including wallpaper, motion video images, audio, and links to other multimedia documents"* (page 5, paragraph 66).

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Gupta discloses a web page. Gupta recites: *"When a user of a client computer 15 accesses a web page containing streaming media, a conventional web browser of the client computer 15 contacts the web server 12 to request a Hypertext Markup Language (HTML) page"* (page 2, paragraph 31).

Gupta discloses an interactive learning system with students and instructors. Gupta recites: *"These annotations typically correspond to a particular temporal location in the multimedia presentation and can provide a replacement for much of the "in-person" interaction and "classroom discussion" that is lost when the presentation is not made "in-person" or "live". As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a "classroom discussion" to occur via these annotations"* (page 1, paragraph 6).

Gupta disclose an annotation field. Gupta recites: *"FIG. 5 shows an exemplary structure for an annotation entry 180 that is maintained by annotation server 10 in annotation meta data store 18 of FIG. 3. In the illustrated example, the annotation entry 180 includes an author field 182, a time range field 184, a time units field 186, a creation time field 188, a title field 190, a content field 192"*

14. **Regarding dependent claims 46 and 47,** Gupta discloses a web page for an Internet (claim 46) or an intranet (claim 47). Gupta recites: *"The communications network in FIG. 1 comprises a public network 16 such as the*

Internet. The data communications network might also include, either in addition to or in place of the Internet, local-area networks and/or private wide-area networks" (page 2, paragraph 26).

15. **Regarding dependent claim 48**, Gupta discloses automatically displaying the annotation field upon entry into the interactive learning program in Figure 10 at reference signs 454 and 456 (shown as "*Annotation Screen*" and "*Media Screen*").
16. **Regarding dependent claim 50**, Gupta discloses students participating in interactive learning. Gupta recites: "*As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a "classroom discussion" to occur via these annotations*" (page 1, paragraph 6).
17. **Regarding dependent claim 51**, Gupta discloses students using the annotations filed to take notes. Gupta recites: "*By way of example, media content corresponding to a lecture may include the following sets: "instructor's comments", "assistant's comments", "audio comments", "text comments", "student questions", and each student's personal comments"* (page 6, paragraph 69).

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18. **Regarding dependent claim 52**, Gupta discloses saving the notes of the students. Gupta recites: *"Annotation server 10 controls the storage of annotations"* (page 2, paragraph 29).
19. **Regarding dependent claim 53**, Gupta discloses saving the notes independently of the interactive learning program in Figure 1 at reference sign 11 (shown as *"Streaming Media Server"* which is the interactive learning program as described above) and reference sign 17 (shown as *"Annotation Content Store"*).
20. **Regarding dependent claims 54 and 55**, Gupta discloses the ability to search saved notes by all users (claim 54) and by instructors (claim 55). Gupta recites: *"Selection of a query button 248 causes interface module 152 to provide a "query" interface, from which a user can enter search criteria to find particular annotations"* (page 7, paragraph 82).
21. **Regarding dependent claim 57**, Gupta discloses storing the annotations to the web page as described above. Gupta further discloses the simultaneous saving of the annotations by the Annotations Back End (shown in Figure 3 at reference sign 151 as *"ABE"*) on the client (reference sign 15) and to the web page. Gupta further recites: *"Annotation content authored at client 15, using user interface 152, is received by ABE 132 and maintained in annotation content store 17. Received meta data (control information) corresponding to the annotation content is maintained in annotation meta data store 18. The annotation content and meta data can be stored in any of*

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a variety of conventional manners, such as in SQL relational databases (e.g., using Microsoft "SQL Server" version 7.0, available from Microsoft Corporation)" (page 4, paragraph 47).

22. **Regarding claims 58-60**, the claims contain substantially the same subject matter as claims 53-55, respectively, and are rejected with the same rationale.
23. **Regarding claims 62-65**, the claims are directed toward a method for the system of claims 45-48, respectively, and are rejected with the same rationale.
24. **Regarding claim 66**, the claim is directed toward a method for the system of claim 52, and is rejected with the same rationale.
25. **Regarding claims 67**, the claim is directed toward a method for the system of claim 53, and is rejected with the same rationale.
26. **Regarding claims 68**, the claim is directed toward a method for the system of claim 57, and is rejected with the same rationale.
27. **Regarding claims 69**, the claim is directed toward a method for the system of claim 53, and is rejected with the same rationale.

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

29. Claims 49, 56 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Pellegrino et al. US Patent 6,149,441, filed 11/6/1998, patented 11/21/2000 (hereinafter Pellegrino).

30. **Regarding dependent claims 49 and 56**, Gupta discloses a document annotation system that uses web pages to implement interactive learning programs with annotation fields for use and review by instructors and students, as described above. Gupta fails to disclose instructors creating the interactive learning programs (claim 49) or using the annotations to improve the interactive learning programs (claim 56).

Pellegrino discloses instructors creating the interactive learning program. Pellegrino recites: *“The server computer further includes a lesson material database for storing lesson material, ... and a lesson builder for allowing a teacher user to interactively create a new lesson plan via the display and the input means”* (column 2, lines 46-54).

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Pellegrino also discloses instructors improving the interactive learning program. Pellegrino recites: *"The lesson builder includes provision for allowing the teacher user to search the lesson material database for the selected lesson material, and to retrieve the selected lesson material when found; to search the lesson database for the selected lesson material, and to retrieve the selected lesson material when found; and to incorporate the selected lesson material into the new lesson in a selected order with respect to other lesson material"* (column 2, lines 55-62).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to use the annotation control system of Gupta with the educational authoring system of Pellegrino in order to provide an instructor authoring system that incorporates feedback from students.

31. **Regarding claim 61**, the claim contains substantially the same subject matter as claim 56, and is rejected with the same rationale.

Response to Arguments

32. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the canceling of these claims. The ground(s) of rejection for new claims 45-69 is described above.

Conclusion

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

34. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

| <u>Patent</u> | <u>Date</u> | <u>Inventor</u> |
|----------------|-------------|-------------------|
| • US-6,139,330 | 10-2000 | Ho et al. |
| • US-6,164,974 | 12-2000 | Carlile et al. |
| • US-6,212,358 | 04-2001 | Ho et al. |
| • US-6,288,753 | 09-2001 | DeNicola et al. |
| • US-6,302,698 | 10-2001 | Ziv-El, Jakob |
| • US-6,386,883 | 05-2002 | Siefert, David M. |
| • US-6,411,796 | 06-2002 | Remschel, Ronald |
| • US-6,427,063 | 07-2002 | Cook et al. |
| • US-6,464,505 | 10-2002 | Pocock, Rodney W. |
| • US-6,471,521 | 10-2002 | Dornbush et al. |

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- US-6,516,340 02-2003 Boys, Mark A.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
January 4, 2005


STEPHEN HONG
SUPERVISORY PATENT EXAMINER